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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,454	10/27/2000	Miri Seiberg	JBP0518	5753

7590 05/06/2002

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/06/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,454

Applicant(s)

SEIBERG ET AL.

Examiner

Marina Lamm

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed 12/27/01. Claims pending are 1-29.

Information Disclosure Statement

1. The information disclosure statement filed 12/27/01 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent. It has been placed in the application file, but the information referred to therein has not been considered.

The applicant has an obligation to call the most pertinent prior art to the attention of the Patent Office in a proper fashion. Burying one reference in one hundred other IDS references is like citing nothing. *PENN YAN BOATS, INC. v. SEA LARK BOATS, INC.*, 175 USPQ 260 (DC Sfla 1972). *Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc.*, 24 USPQ2d 1801 (U.S. Dist. N. Dist.)

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being

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examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 5, 8, 11, 13-16, 18-22 and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Voegeli et al. (US 5,322,839).

Voegeli et al. teach cosmetic and dermatological compositions comprising powdered protein fraction from Leguminosae seeds, such as soybeans and lima beans, and a water-soluble preservative, such as methylparaben. See Abstract; col. 2, lines 40-65; col. 3, lines 39-42; Example 1. The compositions of Voegeli et al. may contain thickening agents (e.g. cellulose rubber) and may be surfactant-free. See Example 12. The soybean protein fraction exhibits trypsin-inhibiting activity and provides hydrating, itch-soothing, anti-inflammatory and elasticity increasing effects. See col. 5, lines 2-5; Example 6. The methods claimed in Claims 15, 16, 18, 20, 21 and 22 are inherent in the reference. Thus, the anti-inflammatory properties of the Voegeli's composition will inherently even skin tone, treat or prevent acne, treat sun burn and even skin texture. Further, the elasticity increasing properties of the Voegeli's composition will inherently even skin texture and treat cellulite. The hydrating properties of the composition will inherently reduce the shine and oiliness of the skin.

Thus, Voegeli et al. teach each and every limitation of Claims 1, 2, 5, 8, 11, 13-16, 18-22 and 25-28.

4. Claims 1-23 and 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Costanzo (US 6,323,219).

Costanzo teaches topical compositions comprising soy milk, soy paste or soy extract rich in soybean trypsin inhibitor. See Examples 11 and 12; col. 28, lines 50-58. The compositions of Costanzo also contain a viscosity builder, preservative (e.g. methyl paraben), chelating agent (e.g. disodium EDTA), antioxidants (e.g. BHT) and/or vitamins (e.g. retinol). See Example 14; col. 23, Table F; col. 10, lines 6-10. For concentrations see, e.g., Table F. Costanzo teaches compositions that contain no or little surfactant. See Example 16, 18. The compositions of Costanzo are used to treat skin pigmentation, inflammatory conditions such as psoriasis, rashes and skin imperfections such as wrinkles, etc. See col. 30, lines 14-17.

Thus, Costanzo teaches each and every limitation of Claims 1-23 and 25-29.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Costanzo in view of either Bissett et al. or Knight et al.

Costanzo applied as above.

The reference does not explicitly teach caffeine of the instant claim. However, Bissett et al. teach using caffeine as anti-cellulite agent. See col. 10, line 57. Knight et al. also teach cosmetic compositions containing caffeine powder. See Example I.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use caffeine of Bissett et al. or Knight et al. in cosmetic products of Costanzo for its art-recognized purpose. The selection of a known material based

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on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

7. Claims 3, 4, 6, 7, 9, 17, 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voegeli et al. in view of Costanzo.

Voegeli et al. applied as above.

Voegeli et al. do not teach antioxidants, chelating agents, retinol and/or thickening agents of the instant claims. However, it is known to employ these agents in cosmetic compositions containing soy products. See Costanzo above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use antioxidants, chelating agents, retinol and/or thickening agents of Costanzo in cosmetic compositions containing soy products of Voegeli et al. for their art-recognized purpose and with a reasonable expectation of beneficial results such as achieving improved stability of the compositions.

With respect to Claim 17, Voegeli et al. do not teach the claimed method of depigmenting the skin. However, Costanzo teaches that compositions containing soy products containing soybean trypsin inhibitor are able to lighten skin color. See col. 20, Example 11. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use compositions of Voegeli et al. for depigmenting the skin as suggested by Costanzo.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Voegeli et al. in view of Costanzo and Bissett et al.

Voegeli et al. and Costanzo applied as above.

Neither reference teaches caffeine of the instant claim. However, Bissett et al. teach using caffeine as anti-cellulite agent. See col. 10, line 57. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use caffeine of Bissett et al. and retinol of Costanzo in cosmetic products of Voegeli et al. for their art-recognized purpose.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

9. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,622,690.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

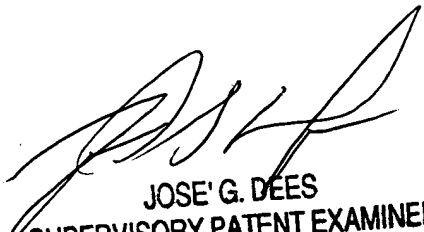
The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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JOSE G. DEES
SUPERVISORY PATENT EXAMINER
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